

Drawing Amendments:

Applicant submits no drawing amendments.

REMARKS

Claims 1-14 are pending in this Application. Claims 1-14 were rejected. The Applicant has cancelled claims 3, 4, 5, 10, 11, and 12. Applicant has amended claims 1, 2, 6, 7, 9, 13 and 14. Applicant has withdrawn claim 8 in response to Examiner's election requirement.

Election requirement under 35 U.S.C. 121

Applicant elects Group 1 (elastomeric), under traverse, in response to the Examiner's request that an election be made between Group 1 (elastomeric) and Group 2 (tie string). Claims 1, 2, 6, 7, 9, 13, and 14 are all readable on the invention with an elastomeric affixing loop, i.e., Group 1. Claim 7 is a generic claim readable on a variety of affixing means including elastomeric loops.

Applicant traverses the Examiner's election requirement because Group 1 and Group 2 are not patentably distinct inventions. Rather, the tie-string embodiment of Claim 8 merely describes an alternate affixing means. The affixing loop described in Applicant's design is a small part of the invention and the difference between an elastomeric loop and a tie string affixing loop is slight in relation to the overall function and operation of said invention. Therefore, Group 1 and Group 2 are not patentably distinct.

Benefit of the provisional application's filing date

Examiner has stated that the Applicant has not complied with the conditions necessary to receive benefit from the provisional application 60/429678, because "...the provisional application fails to show the elastomeric loop, the tie string, and the material as set forth in the present application."

Applicant argues that the “elastomeric loop is taught by the “elastic band lining” shown in the second drawing submitted with the provisional application.

Additionally, the Technical Field section of the provisional application describes the decorative covers as having “...an elastic lining at one or both ends....”

Applicant further argues that the material used to make the decorative cover for a trash and/or recycle receptacle is described in the Technical Field section of the provisional application as “...printed, light weight, water resistant, disposable, (and/or re-usable) plastic bag like outer liners...” Applicant admits that no mention of the tie string affixing loop is described in the provisional application. Therefore, Applicant argues that he is entitled to receive the benefit of the filing date of provisional application 60/429678 for the material and elastomeric loop(s) as later described in more detail in Applicant’s utility application.

Objections to Applicant’s Drawings

Examiner argues that Applicant has failed to comply with 37 C.F.R. 1.83(a), because the submitted drawings do not show every feature of the invention specified in the claims. Specifically, Examiner states that “...the first and second affixing means, being a tie string in claim 8, must be shown....” Although claim 8 has been withdrawn in response to Examiner’s election requirement, Applicant argues that the tie string is explicitly shown as the first affixing means in Figures 2b and 4. Applicant also points out that it is stated on page 10 of the application, in the Detailed Description of the Preferred Embodiment, that “[w]hile the present invention has been described in the context of elastomeric loops 16a, 16b, it is to be appreciated that the

invention suggests other attachment embodiments. Figure 4 illustrates an adjustable tie string embodiment....” In light of this citation stating that the affixing means, shown as 16a and 16b in Figures 1, 2b, 3 and 5, can be means other than elastomeric loops, and tie strings are specifically mentioned as alternate affixing loops, which are also explicitly shown in Figures 2b and 4. Applicant argues that the drawings adequately show the tie string feature as being both the first and second affixing means as required under 37 C.F.R. 1.83(a).

All amendments are fully supported by the specification and no new matter has been added. The Examiner is respectfully requested to reconsider the rejection of this Application in light of the foregoing remarks.

The listing of references

Applicant has attached an Information Disclosure Statement describing the prior art references in response to Examiner's rejection.

35 U.S.C. §102(e)

Claims 1, 2, 6, 7, 9, 13, and 17 are rejected under Hinchliff

The Examiner rejected claims 1, 2, 6, 7, 9, 13 and 17 under 35 U.S.C. §102(e) as being anticipated by Hinchliff (2,035,384). It is assumed that the Examiner is referring to claim 14 when the Examiner cites claim 17 as there is no claim 17 in the pending application. Therefore, Applicant will direct arguments toward claim 14, when Examiner discusses claim 17.

In making the rejection, the Examiner stated that:

Hinchliff teaches a cover with decoration (pg. 2, col. 1, ln. 65-67) having two end(s) with elastomeric loops at two ends (pg.2, col. 2, ln. 33, 43, , 50-55: Figs. 18, 12, 13, and 14). It is noted that it is an intended use to using the cover with a trash receptacle. Furthermore, it is noted that the Hinchliff disclose several receptacles (pg.1, col. 1, ln. 9-11) that are considered a trash receptacle as claimed, i.e., they contain trashes. With respect to the ledge in claim 17, the cover in Hinchliff is capable of forming a ledge due to its flexibility as claimed.

In fact, the Hinchliff device does not disclose a cover for a trash receptacle. The list of items disclosed in the Hinchliff patent, in the sections cited by the Examiner include, beverage glasses, bottles, decanters, mixers, shakers, flower vases, bowls, candlesticks, cups, saucers, plates, and dinner and tea sets. (See Hinchliff pg. 1, col. 1, lns. 19-20.) None of these items are designed to "contain trash" as the examiner claims.

For a 35 U.S.C. §102 rejection, it is well established case law that "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Hinchliff does not disclose a cover for a trash and/or recycle receptacle, which is an essential element of Applicant's invention. While it is true that almost any container has the capacity to contain trash, none of the containers that are taught as being coverable by Hinchliff's invention are designed to contain trash or recycling. The American Heritage Dictionary, fourth edition, defines 'trash' as

“worthless or discarded material or objects; refuse or rubbish.” This is a very broad definition that can include a wide variety of items. Such items may be as small as cigarette butts or as large, or larger than discarded furniture. Obviously, small pieces of trash, such as cigarette butts, can be placed in bottles, flower vases, or bowls, which can be covered by Hinchliff’s invention, but this fact does not make bottles, flower vases, or bowls trash receptacles because they are not designed to contain such trash.

In contrast, Applicant’s invention is a cover for use with containers that are specifically designed to be trash receptacles. If any item that merely has the capacity to “contain trash” can be deemed a trash receptacle, then an automobile could be considered a trash receptacle. Therefore, an automobile cover, see Poirier (2688513) and others, could then be rejected as being anticipated under Hinchliff. Clearly, this broad definition for a trash receptacle makes the term almost meaningless and should not be used to lump shakers, tumblers, and flower vases into the same category as trash cans, dumpsters, and wastebaskets. Every claim made by Applicant describes a cover for a trash and/or recycle receptacle, whereas the Hinchliff patent neither claims nor describes a cover for a trash and/or recycle receptacle. Therefore, Applicant’s invention, as claimed in amended independent claims 1, 7, and 14, and Applicant’s currently amended dependent claims 2, 6, 7, 9, and 13, are patentably distinct from Hinchliff.

Furthermore, the Hinchliff patent does not describe or claim a ledge as claimed by Applicant in Claims 7, 9, 13, and 15, and it is not sufficient that a

ledge could be created with the jacket in Hinchliff. As cited above, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). (emphasis added) Hinchliff does not "expressly" or "inherently" claim the use of a cover to create a ledge. First, Hinchliff does not expressly describe or claim a ledge as claimed by Applicant, because the word 'ledge,' or any word of similar meaning is not mentioned anywhere in the Hinchliff patent. Secondly, Hinchliff does not inherently claim a ledge as claimed by Applicant. According to The American Heritage Dictionary, fourth edition, the word 'inherently' is synonymous with the word 'essentially.' Therefore, Hinchliff can only anticipate Applicant's use of a ledge if it is an essential part of Hinchliff's invention, which is not the case, because none of Hinchliff's covers have ledges.

Hinchliff's jackets are primarily designed for containers that dispense liquids or powders, whereas Applicant's invention is designed only to receive items. A ledge can be helpful as a guide for containers such as a trash can, which receive items, but it would only get in the way of the dispensation functions of Hinchliff's jacketed items. For example, a ledge formed over the rim of a glass or cup by one of Hinchliff's jackets would prevent the user from being able to drink from the glass or cup. Therefore, Hinchliff teaches away from the use of such a ledge. Additionally, the fact that no utility for a ledge is described in the Hinchliff patent, lends support for the argument that Hinchliff never intended a ledge formed by a decorative cover to be an element of his invention.

It is also not a certainty that a ledge could be formed by the Hinchliff jacket. If the mid-section of Hinchliff's tube has elasticity of a strength that is greater than or equal to the elasticity of the elastomeric loops at the ends of the tube, a ledge cannot be formed by the tube. Rather, the tube would form a sort of cone, which would not have any obvious utility for either the Hinchliff invention or Applicant's invention. It is likely that the Hinchliff jacket would form this cone because the "knitted fibrous textile material" used to form the tube is described by Hinchliff's claims and specification as having an "inherent elasticity."

For all of the reasons mentioned above, Applicant's invention, as claimed in amended independent claims 1, 7, and 14 are patentably distinct from Hinchliff, and Applicant's currently amended dependent claims 2, 6, 7, 9, and 13, which depend from Applicant's patentable independent claims 1, 7, and 14, are therefore patentable for at least the same reasons as applicant's patentable independent claims 1, 7, and 14.

35 U.S.C. §102(b)

Claims 7 and 8 are rejected under Moone or Riggs et al.

The Examiner rejected claims 7 and 8 under 35 U.S.C. §102(b) as being anticipated by either Moone (2035384) or Riggs et al. (5439727).

In making the rejection, the Examiner stated that:

Either Moone or Riggs teaches a tube (note that in the covering of Moone formed into a tube as claimed) with first and second securing means being tie strings and note the ledge can be formed by the cover as claimed.

As stated, for a 35 U.S.C. §102 rejection, it is well established caselaw that "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claim 8 has been withdrawn in response to Examiner's election requirement. Applicant's amended independent claim 7 is patentably distinct from the devices disclosed in either Riggs et al. or Moone. The device disclosed in the Riggs et al. reference is an anti-scuff device used to prevent vehicle tires from scuffing or marring surfaces. The device disclosed in the Moone reference is a protective covering used to prevent the ends of rolled felt, paper, asbestos paper, prepared roofing, and similar products from becoming damaged. Applicant's Claim 7 is directed towards decorative covers for trash and/or recycle receptacles and is not intended for use with tires of any kind or rolled felt, paper, asbestos paper, or prepared roofing. The utility of Applicant's cover is primarily its decorative function and it is not intended to protect floor surfaces from scuffing, such as in Riggs et al., or to protect the item being covered, as in Moone. Furthermore, the fact that both Riggs and Moone describe a cover using a tie string is no longer relevant because Claim 8, which is the only claim directed toward a cover utilizing a tie-string, has been withdrawn. For all of the

reasons listed above, Applicant's amended independent claim 7 is patentably distinct from the devices disclosed in either Riggs et al. or Moone.

Claims 1, 3, 5, 7, 10, and 12 are rejected under Garofalo et al.

The Examiner rejected claims 1, 3, 5, 7, 10, and 12 under 35 U.S.C. §102(b) as being anticipated by Garofalo (6508282).

In making the rejection, the Examiner stated that:

Garofalo teaches a cover with decoration having at least one end with an elastomeric loop.

The device disclosed in the Garofalo et al. reference is a decorative cover for a propane tank. Applicant's claims 3, 5, 10 and 12 have been canceled. Applicant's amended claims 1 and 7 are directed solely towards a decorative cover for a trash and/or recycle receptacle, and are not directed toward a decorative cover for a propane tank. Furthermore, the invention described in Applicant's amended claim 7 also describes an "annular ledge," which is not claimed or described by the Garofalo reference. For these reasons, Applicant's amended claims 1 and 7 are patentably distinct from the Garofalo reference.

35 U.S.C. §103(a)

Claims 1-2, 7, 9, 13 and 14 over Warnberg in view of either Hinchliff or Rosenthal

The Examiner rejected claims 1-2, 7, 9, 13, and 14 under 35 U.S.C. §103(a) as being unpatentable over Warnberg (D214288) in view of either Hinchliff (2035384) or Rosenthal (5553733).

In making the rejection, the Examiner stated:

Warnberg meets all claimed limitations except the elastomeric material.

Either Hinchliff or Rosenthal teaches that it is known in the art to provide elastomeric material for securing the cover. It would have been obvious to one of ordinary skill in the art to provide elastomeric material at two ends in Warnberg as taught by either Hinchliff or Rosenthal for securing the cover to the receptacle.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. §103, the Examiner must demonstrate that there is a suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine the reference teachings. Furthermore, the prior art references must teach or suggest all of the claimed features. It is well settled law that the prior art itself must provide the motivation for a proposed alteration of a reference. Ex parte Chicago Rawhide Manufacturing Co., 220 U.S.P.Q. 351, (B.O.P.A. 1984). Moreover, the suggestion must be plain and clear or the rejection is untenable. Fromson v. Offset Plate, Inc., 225 U.S.P.Q. 26, 32 (Fed. Cir. 1985); Kimberly-Clark Corp. v. Johnson & Johnson, 223 U.S.P.Q. 603, 610 (Fed. Cir. 1984). The Examiner is not free to pick bits and pieces from the prior art and, with the hindsight benefit of applicants' disclosure, attempt to reconstruct the invention. Orthopedic Equipment, Inc. v. U.S., 217 U.S.P.Q. 193, 199 (Fed. Cir. 1983).

Notwithstanding the Examiner's argument, Applicant's dependent claims 2 and 3 depend from applicant's patentable amended independent claim 1 which now claims a cover wherein the "...tube is constructed from a polymeric material which is impervious to water and odors." There is no suggestion in the Warnberg

reference that the cover is constructed from a tube which is designed to “fit over and cover any shape and many sizes of-trash and/or recycle receptacle” as is recited in applicant’s amended independent claims 1, 7, and 14. Secondly, there is no suggestion that the Warnberg reference teaches an annular ledge as described in claims 7, 9, 13, and 14 of Applicant’s invention. Lastly, there is no motivation in the Warnberg reference or suggestion that “said tube is constructed of a polymeric material which is impervious to water and odors” as is recited in applicant’s amended independent claims 1, 7, and 14. Therefore, applicant’s amended independent claims 1, 7, and 14 are patentably distinct from the device cited in the Warnburg reference, and given the dependence of applicant’s dependent claims 2, 9 and 13 on patentable amended independent claims 1 and 7, applicant’s dependent claims 2, 9 and 13 are patentably distinct from the device in Warnburg for at least the same reasons as applicant’s patentable independent claims 1, 7, and 14.

Hinchliff teaches away from using the elastomeric material he used for his “jackets” with trash or recycling receptacles as used in Warnburg. Nearly all of the claims in the Hinchliff patent describe a “jacket” made of “knitted...fibrous textile material.” This type of material is not suitable for use with trash and/or recycled materials because it would quickly become soiled and unsightly, which would completely defeat the purpose of a decorative cover. This problem would be exacerbated by Applicant’s ledge element for guiding trash and/or recycling into the covered receptacles. This ledge is designed to come into contact with

the trash and/or recycling causing it to quickly become soiled if it were not made from a suitable material.

By making the decorative cover from a “polymeric material” or a “water-proof material,” as claimed by Applicant, the decorative cover will be more stain resistant and more easily cleaned when necessary. Likewise, Applicant claimed decorative cover made from a “paper material” that can be discarded after use. In contrast, a “knitted” decorative cover, such as those claimed by Hinchliff, for a trash and/or recycle receptacle would be difficult to clean and too expensive to discard.

Likewise, Rosenthal teaches a “cloth-like material” to make the covers described in that patent. It is supposed that such a material would have suitability issues similar to the material used by Hinchliff described above. The Rosenthal invention also utilizes a complex system for keeping the cover in place which is very different from Applicant’s. It does not use elastomeric material to attach the cover to the trash can such as applicant does. For these reasons it would not be obvious to one skilled in the art to create Applicant’s invention in view of Hinchliff, Rosenthal, and Warnberg.

35 U.S.C. §103(a)

Claims 3, 5, 10 and 12 over Warnberg in view of Szuszkiewicz

The Examiner rejected claims 3, 5, 10, and 12 under 35 U.S.C. §103(a) as being unpatentable over Warnberg (D214288), as set forth above, and further in view of Szuszkiewicz (2003/0010415).

In making the rejection, the Examiner stated:

It would have been obvious to one of ordinary skill in the art to use plastic in the cover of Warnberg as taught by Szuszkiewicz to provide the desired material for the cover.

Applicant's claims 3, 5, 10, and 12 have been cancelled; but claims 3 and 10 have been incorporated into amended claims 1 and 7. Therefore, Szuszkiewicz's potential relevance to a decorative designed to "fit over and cover any shape, and many sizes" of trash and/or recycle receptacle with said material being made from a "polymeric material" will be discussed here in detail.

It is true that the Szuszkiewicz reference describes the use of neoprene fabric as the material of choice for constructing the inner lining of the Szuszkiewicz invention. However, it should first be stated that neoprene is not a "plastic," as stated by the Examiner, but is a type of synthetic rubber. More important is how neoprene is used in the Szuszkiewicz reference. In that reference neoprene is only a small part of an elaborate decorative cover for a diaper pail that transforms the pail into a large stuffed teddy bear or other stuffed animal wearing a bathrobe. Neoprene is not any part of the decoration provided by the Szuszkiewicz invention, rather its inherent elasticity functions primarily to attach the stuffed teddy bear exterior to the diaper pail. Additionally, Neoprene's utility in the Szuszkiewicz reference is its ability to protect the cloth decoration from odors and wetness associated with the used diapers placed within the covered diaper pail.

In contrast to the Szuszkiewicz reference, Applicant's cover, as described in amended claims 1 and 7, comprises a single tube made from a "polymeric

material.” Applicant’s cover, by itself, is decorative, has the ability to fit over and cover any shape and many sizes of trash and/or recycle receptacle, and is water and odor resistant. It is not part of a larger and more complex cover such as the neoprene tube in the Szuszkiewicz reference.

Szuszkiewicz’s use of a neoprene tube actually teaches away from applicant’s claim 7 for reasons similar to why Hinchliff teaches away from Applicant’s invention. Neoprene is too thick and uniformly elastic to form an annular ledge. It would form a cone-like shape just as the knitted fabric in Hinchliff would do. Such a shape would make it more difficult to put trash in the covered receptacle, and therefore, would teach away from the annular ledge feature of Applicant’s invention.

Additionally, the neoprene tube used by Szuszkiewicz will not fit over and cover the same variety of shapes and sizes that the polymeric material used by Applicant can fit over and cover. Szuszkiewicz’s use of neoprene requires that it be specifically cut to meet the dimensions of the diaper pale being covered. If the neoprene tube is too large it will not effectively attach the entire cover apparatus to the diaper pale and it will fall off or slump. If the cover is cut too small it will not fit over the diaper pale. This is probably why Szuszkiewicz specifically mentions The Diaper Genie brand diaper pale as the preferred container to be covered with that invention. In contrast, Applicant’s invention is designed to cover trash and/or recycle receptacles that range in size from large to small, tall to short, and has the capability to fit over a variety of shapes (i.e. round, square, etc.).

For all of these reasons, Applicant's invention, as claimed in currently amended independent claims 1 and 7 are patentably distinct from Szuszkiewicz, and Applicant's currently amended dependent claims 3 and 10, which depend from Applicant's patentable independent claims 1 and 7, are therefore patentable for at least the same reasons as applicant's patentable independent claims 1 and 7.

35 U.S.C. §103(a)

Claim 8 over Warnberg in view of either Moone or Riggs et al.

The Examiner rejected claim 8 under 35 U.S.C. §103(a) as being unpatentable over Warnberg (D214288) rejection, as set forth above in paragraph 5, and further in view of either Moone (1479151) or Riggs et al. (5439727).

In making the rejection, the Examiner stated:

It would have been obvious to one of ordinary skill in the art to use tie strings in the cover of Warnberg as taught by either Riggs et al. or Moone to provide the alternative securing means.

Claim 8 has been withdrawn in response to Examiner's election requirement.

35 U.S.C. §103(a)

Claims 3-5 and 10-12 over either Hinchliff or Garofalo in view of Bassi.

The Examiner rejected claims 3-5 and 10-12 under 35 U.S.C. §103(a) as being unpatentable over either Hinchliff or Garofalo in view of Bassi (4589149).

In making the rejection, the Examiner stated:

Bassi teaches that it is known in the art to provide a cover from plastic and paper (col. 1, ln. 57-57). It would have been obvious to one of ordinary skill in the art to make the cover from paper in either Hinchliff or Garofalo as taught by Bassi to provide the desired material.

Applicant's dependent claims 3-5 and 10-12 have been cancelled, but dependent claims 3 and 10 have been incorporated into amended independent claims 1 and 7, and dependent claims 4 and 11 have been incorporated into new independent claim 15. Therefore, Bassi's potential relevance to a decorative cover for a trash and/or recycle receptacle made from a paper or plastic material will be discussed here in detail.

Bassi describes a disposable toilet seat cover constructed from a "plastified paper." Plastified paper appears to be a type of laminated paper, though no specific definition is provided by Bassi.

As mentioned above, neither Garafalo (propane tank) nor Hinchliff (glassware, etc.) teaches a decorative cover for a trash and/or recycle receptacle. Therefore, one of ordinary skill in the art could not combine those two inventions with Bassi to create Applicant's cover for a trash or recycle receptacle. Furthermore, Bassi's invention has no decorative function as does Applicant's invention. It is intended to cover a toilet seat for "sanitary purposes" only.


For these reasons, the combination of Bassi with either Hinchliff or Garafalo would not allow one of ordinary skill in the art to create Applicant's invention.

CONCLUSION

In view of the foregoing amendment and remarks, it is believed that this Application is now in condition for allowance. Early and favorable reconsideration is respectfully solicited.

If the Examiner has any questions regarding the foregoing amendment and remarks, or if prosecution of this Application could be furthered by a telephone interview, the Examiner is requested to telephone the Applicant's undersigned attorney.

Respectfully submitted,

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Date: September 7, 2005

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Non-provisional patent application of

Sharif Alexander Hamdan

Group Art Unit: 3727

Application No: 10/694,529

Examiner Name: Tri M. Mai

For: DECORATIVE DISPOSABLE TRASH RECEPTACLE COVERS

Filing Date: October 27, 2003

Mailing Date of

Office Action: April 7, 2005

CERTIFICATE OF MAILING

Commissioner for Patents
P.O. Box 1450
Arlington, VA 22313-1450
Mail Stop Response

Date of Deposit: September 7, 2005

I hereby certify that this Response to Office Action and fee are being deposited with the United States Postal Service via First Class Mail on the date indicated above, addressed to Commissioner for Patents, P.O. Box 1450, Arlington, VA 22313-1450, Mail Stop Response.

SCOTT J. FIELDS

Date: September 7, 2005

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